

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: *Harley et al.*

SERIAL No.: 10/562,374

I.A. FILING DATE: 06/23/2004

FOR: **COMPOSITIONS AND METHODS FOR
INCREASING TELOMERASE ACTIVITY**

CONFIRMATION No.: 7952

Renewed Petition under 37 C.F.R. §1.47(a) and Request for Reconsideration

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. Applicants hereby request reconsideration of the DECISION ON PETITION mailed November 9, 2006 and submit this renewed Petition under 37 C.F.R. §1.47(a), to make the present application on behalf of the omitted inventor, David Miller-Martini, who has refused to join in the application. A Petition for Two-month Time Extension accompanies this request with the time extension fee due of \$450.00.

2. A grantable Petition under 37 C.F.R. §1.47 must be accompanied by (1) the fee as specified in 37 C.F.R. §1.17(h); (2) a statement of the last known address of the non-signing inventor(s); (3) an oath or Declaration executed by the other inventor(s) on behalf of themselves and the non-signing inventor, and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

3. On September 7, 2006, Applicants mailed a Petition under 37 C.F.R. §1.47(a) including the fee under 37 CFR § 1.17(h); and the last known address of the omitted inventor(s). This satisfies Items 1 and 2.

4. To satisfy the requirements stated in the Decision on Petition, Applicants additionally submit herewith (1) a petition including factual proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort, and (2) four individually signed Declarations executed by each of the cooperating inventors which includes an unsigned signature block for the non-signing inventor.

Statement of Facts

I, the undersigned, am the attorney of record in the above-referenced application. The following describes, to the best of my knowledge, the facts relied on to establish that Dr. David M. Miller-Martini has refused to sign the application papers (Declaration of Inventorship) in this application.

Dr. Miller-Martini is one of six co-inventors of the subject application.

Dr. Miller-Martini was an employee of Hong Kong University of Science and Technology (HKUST) when he worked on the subject invention, and in accordance with the requirements of his conditions of employment, and Hong Kong law, assigned to HKUST the entire right, title and interest in the inventions set forth in provisional application USSN 60/480,988, to which the above-referenced application claims priority, and any patents "granted thereon and therefor". The assignment, attached hereto as Exhibit A, was executed by Dr. Miller-Martini on October 9, 2003.

Dr. Miller-Martini subsequently left his employment at HKUST. His most recent known address is 409 Pine St., Ridgway PA 15853.

The Notice to File Missing Parts in the above-referenced application was received in the offices of Perkins Coie, LLP on May 15, 2006. Documents to be signed by each inventor, including the Declaration of Inventorship, were prepared at Perkins Coie and sent to Geron Corporation, assignee of the application, on June 9, 2006. A copy of Perkins Coie's cover letter is enclosed as Exhibit B.

The documents were then forwarded by Geron to Mr. Tony Eastham, President and CEO of HKUST, for presenting to the inventors. A copy of Geron's cover letter is enclosed as Exhibit C. Note that the letter emphasizes that the inventor is to sign the Declaration only after having read a copy of the subject application.

On July 11, 2006, our offices received an email (Exhibit D) from a Ms. Kathleen Geubelle, also copied to Dr. Miller-Martini. The email stated that Dr. Miller-Martini had "several concerns" regarding the applications (the above-referenced application and two copending applications) and more specifically stated that "his three concerns pertain to an incorrect reference to his citizenship, current address, and order of inventors listed in the applications". We were asked to contact Dr. Miller-Martini's legal counsel, Mr. David Pontzer, regarding these matters.

(This email refers to the applications that Dr. Miller-Martini "received from HKUST", further establishing that the inventor was presented with a copy of the subject application.)

Our offices subsequently left a message with Mr. Pontzer as instructed, but we did not receive a reply. On August 14, 2006, we sent a reply email (Exhibit E) to Ms. Geubelle, copying Dr. Miller-Martini and Dr. David Earp, chief patent counsel at Geron Corporation. In this email we pointed out that the concerns stated above should not be very difficult to resolve.

On August 17, 2006, Dr. Miller-Martini sent a reply email (Exhibit F) addressed to our offices and copied to Dr. Earp and Dr. Miller-Martini's legal counsel. Dr. Miller-Martini declined to execute the Declaration of Inventorship, stating that "execution of these documents will only occur 'subsequent' to your client [Geron Corp.] and their joint venture partner [HKUST] having obtained an appropriate license to my rights and interests in these drug molecules/fractions/formulations." A later email (Exhibit G) from Dr. Miller-Martini similarly stated that he would execute the documents if "in so doing I do not forfeit my rights and interests in these inventions".

Dr. Miller-Martini's contention that he retains "rights and interests in these inventions" is consistent with the position taken in his letter to the Chairman of HKUST, dated June 16, 2006 (Exhibit H). In that letter he not only asserted these rights and interests but also suggested that he would disclose claimed subject matter (and other confidential information) to "third party competitors" if no license were negotiated between himself and HKUST.

In view of the above, (1) Dr. Miller-Martini has assigned any rights he had in this application to his former employer, HKUST (see assignment, Exhibit A), in accordance with his legal obligations; and (2) Dr. Miller-Martini's stated conditions for executing the application papers (requiring HKUST to negotiate a license) constitute a refusal to execute the application papers.

Additionally, on January 22, 2007 a letter, along with a Declaration of Inventorship, the original Application as filed, and a copy of a Preliminary Amendment as filed on 12/23/2005 was mailed via Certified Mail, Return Receipt Requested, to David M. Miller-Martini at his last known address of 409 Pine Street, Ridgway PA 15853 with a copy of the letter and enclosures sent to his last known attorney, Gwendolyn R. Wood, Ph.D. at The Webb Law Firm, 700 Koppers Building, 436 Seventh Avenue, Pittsburgh, PA 15219. Enclosed is a copy of the RETURN RECEIPT as signed by D. Miller-Martini on 01/27/2007. No signed RETURN RECEIPT was ever received from G. Wood.

Conclusion

The applicants submit that this petition complies with the requirements of 37 CFR §1.47(a) and MPEP §409.03(d), and gives documented evidence that the application papers were duly presented to the inventor, and that the inventor refused to sign the application papers.

Additionally, enclosed are four individually signed Declarations executed by each of the cooperating inventors which includes an unsigned signature block for the non-signing inventor.

The inventors were thus presented with a copy of the complete application papers, in accordance with MPEP §409.03(d), in addition to receiving the documents to be signed.

Applicants submit that this petition complies with the requirements of 37 C.F.R. §1.47(a) and MPEP §409.03(d), and gives documented evidence that the missing inventor refused to join in the application after a diligent effort was made to obtain his signature on the application papers.

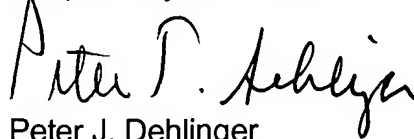
Fee Payment

The two-month time extension fee of \$450.00 accompanies this communication.

No additional fees are believed due, however, the Commissioner is authorized to charge any fees deemed due for timely consideration of this communication to Deposit Account No. 50-2207.

Date: March 9, 2007

Respectfully submitted,



Peter J. Dehlinger
Registration No. 28,006

Correspondence Address:

Customer No. 22918
Phone: (650) 838-4401



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27 JAN 2007 PM 1

First-Class Mail
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PERKINS COIE LLP
Attn: Lynn Kennelly
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- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

DAVID MILLER-MARTINI
409 PINE ST.
RIDGWAY, PA
15853

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A. Signature

[Signature] ☐ Agent ☐ Addressee

B. Received by (Printed Name)

DAVID M. MILLER-MARTINI 1-27-07

C. Date of Delivery

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If YES, enter delivery address below: ☐ No

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4. Restricted Delivery? (Extra Fee)

☐ Yes

2. Article Number
(Transfer from service label)

7000 1530 0004 3393 5544



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January 22, 2007
via certified mail – return receipt requested

David M. Miller-Martini, Ph.D., MBA
409 Pine Street
Ridgway, PA 15853

Re: U.S. National Phase Application No. 10/562,374 filed on 12/23,2005 based on
PCT Patent Application No. PCT/US04/20277 filed on 06/23/2004
for **COMPOSITIONS AND METHODS FOR INCREASING TELOMERASE ACTIVITY**
Geron Corporation Reference No.: 510/200 PCT
Our Reference: 38797-8004.US00

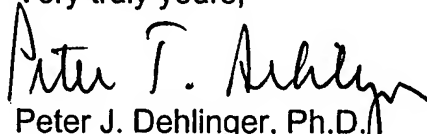
Dear Mr. Miller-Martini:

To complete the requirements of the U.S. Patent and Trademark Office it is necessary for us to submit a Declaration of Inventorship executed by each of the inventors in the above-referenced application. Accordingly, please find enclosed a Declaration of Inventorship for your signature and return. The signature need not be notarized or witnessed, but please date the document. I have also enclosed a copy of the Application as filed with the U.S. Patent and Trademark Office on June 23, 2004 and a copy of a Preliminary Amendment as filed on December 23, 2005.

Please sign and date the enclosed declaration after reviewing the above-referenced documents and return it to our offices at your earliest convenience

If you have any questions, please do not hesitate to contact us.

Very truly yours,


Peter J. Dehlinger, Ph.D.

PJD/lbk
Encs.

cc: Gwendolyn R. Wood, Ph.D.
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436 Seventh Avenue
Pittsburg, PA 15219

D. Earp (via email w/encls.)
C. Franke (via email w/encls.)

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